



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
097209,440	12/10/98	GRUSE	SE9-98-007

LMC1/0914

MICHAEL J. BUCHENHORNER
GUNSTER YDAKLEY
VALDES-FAULI & STEWART
500 EAST BROWARD BLVD SUITE 1400
FORT LAUDERDALE FL 33394

EXAMINER
NGUYEN, N

ART UNIT	PAPER NUMBER
2764	

DATE MAILED: 09/14/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/209,440

Applicant(s)
Gruse et al.

Examiner
Nga B. Nguyen

Group Art Unit
2764



☒ Responsive to communication(s) filed on Dec 10, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-44 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-44 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2764

DETAILED ACTION

1. This Office Action is in response to the communication filed on December 10, 1998, which paper has been placed of record in the file.
2. Claims 1-44 are pending in this application.

Drawings

3. The drawings are objected to because of the Draftsperson's notice, see form PTO-948 for detail. Correction is required.

Specification

4. The disclosure is objected to because of the following informalities: page 150 is missing. Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Art Unit: 2764

6. Claims 8, 10-13, 22-24, 27-32, and 35-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Ahmad, U.S. Patent No. 5,925,127.

Regarding claim 8, Ahmad discloses a system for tracking usage of digital content on user devices comprising:

a plurality of electronic stores for granting licenses to play digital content data to users, each electronic store being coupled to a network (column 9, lines 17-44);

a plurality of content players for playing content data, each digital content player receiving, from the network the digital content data licensed by one of the users (column 8, lines 14-40); and

a logging site coupled to the network for tracking playing of the digital content data (column 8, lines 14-40),

wherein the logging site receives, from the network, play information from each of the digital content players, the play information for each digital content player including a number of times that the digital content data has been played by the digital content player (column 11, lines 43-54).

Regarding claim 10, Ahmad discloses everything claimed as applied above (see claim 8), in addition, Ahmad teaches the system further comprising a digital content site coupled to the network, the digital content site sending the digital content data to the digital content players (column 9, lines 45-57).

Art Unit: 2764

Regarding claim 11, Ahmad discloses everything claimed as applied above (see claim 8), in addition, Ahmad teaches the usage information includes the last time the digital content has been played (column 11, lines 27-35).

Regarding claim 12, Ahmad discloses everything claimed as applied above (see claim 8), in addition, Ahmad teaches the play information also includes the identification of the user playing the digital content on the content player (column 10, lines 50-62).

Regarding claim 13, Ahmad discloses everything claimed as applied above (see claim 8), in addition, Ahmad teaches each time one of the digital content players plays the digital content data, the logging site receives the play information from the one digital content players (column 9, lines 1-15).

Regarding claim 22, Ahmad discloses method for tracking usage of digital content on user devices, said method comprising the steps of:

accepting a license to play digital content data to a user (column 9, lines 17-44);

receiving the licensed digital content data to a digital content player for the user (column 9, lines 45-57);

logging play information in the digital content player each time the digital content data is played by the digital content player (column 11, lines 43-54); and

sending the logged play information to a logging site at a predetermined time or at

Art Unit: 2764

predetermined intervals to enable the tracking of use of the licensed digital content data (column 10, lines 35-50).

Regarding claim 23, Ahmad discloses everything claimed as applied above (see claim 22), in addition, Ahmad teaches the license is granted to the user by an electronic commerce host (column 9, lines 16-37).

Regarding claim 24, Ahmad discloses everything claimed as applied above (see claim 22), in addition, Ahmad teaches the step of storing the licensed digital content data on at least one of a hard disk, a removable disk, flash memory, and an optical (column 9, lines 38-65).

Claims 27-28 contain the same limitation as claims 11-12, therefore are rejected by the same rationale.

Regarding claim 29, Ahmad discloses a method for tracking usage of digital content on user, method comprising the steps of:

granting licenses to play digital content data to a plurality of users (column 9, lines 17-44);
for each user, sending licensed digital content data to a digital content player for the user (column 9, lines 45-65); and

tracking playing of the digital content data at a logging site that receives play information from the digital content players of the users, the play information including the number of times that the digital content data has been played by each user for enabling the tracking of usage of the licensed digital content data (column 11, lines 43-54).

Art Unit: 2764

Regarding claim 30, Ahmad discloses everything claimed as applied above (see claim 29), in addition, Ahmad teaches the step of sending the play information to the logging site at a predetermined time or at predetermined intervals (column 11, lines 1-14).

Claims 31-32 and 35-36 contain the same limitation as claims 23-24 and 11-12, respectively, therefore are rejected by the same rationale.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1- 4, 6-7, 14-18, 20-21, 25, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahmad, U.S. Patent No. 5,925,127 in view of Wolfe, U.S. Patent No. 4,796,220.

Regarding claim 1, Ahmad discloses a digital content data player for playing digital content data stored on a storage device, data player comprising:

an interface for connecting with the storage device (column 6, line 40-column 7, line 45);

Art Unit: 2764

a player coupled to the interface for playing the stored digital content data and generating usage information (column 6, line 40-column 7, line 45); and

a transmitter for transmitting the usage information to a logging site on a network, the usage information informing the logging site of at least one of a playing of the stored digital content data by the player (column 9, lines 1-15).

However, Ahmad does not teach the usage information informing the logging site of a copying of at least part of the digital content data from the storage device to an external medium. Wolfe teaches the usage information informing the logging site of a copying of at least part of the digital content data from the storage device to an external medium (column 4, lines 40-column 5, lines 45). It would have been obvious to one with ordinary skill in the art at the time the invention was made to use the usage information as taught by Wolfe in order to improve Ahmad's data player by informing the logging site the digital content data has been copied to an external medium for the purpose of tracking the usage of digital content by the logging site.

Regarding claim 2, Ahmad discloses everything claimed as applied above (see claim 1), in addition, Ahmad teaches data player further comprising a receiver coupled to the network and

Art Unit: 2764

player, the receiver receiving the digital content data from a digital content host on the network (column 9, lines 45-57).

Regarding claim 3, Ahmad discloses everything claimed as applied above (see claim 1), in addition, Ahmad teaches the storage device is one of a hard disk, a removable disk, flash memory, and an optical disk (column 6, lines 50-60).

Regarding claim 4, Ahmad discloses everything claimed as applied above (see claim 1), in addition, Ahmad teaches the external medium is one of a compact disc, a DVD disc, a mini-disc, flash memory, and a digital tape (column 6, lines 60-67).

Regarding claim 6, Ahmad discloses everything claimed as applied above (see claim 1), in addition, Ahmad teaches the usage information includes the last time the digital content has been played (column 11, lines 27-35).

Regarding claim 7, Ahmad discloses everything claimed as applied above (see claim 1), in addition, Ahmad teaches the usage information includes the identification of the user playing the digital content on the content player (column 10, lines 50-62).

Regarding claim 14, Ahmad discloses a method for tracking usage of digital content on user devices, said method comprising the steps of:

Art Unit: 2764

granting a license to play digital content data to a user (column 9, lines 15-44);
accepting the licensed digital content data to a digital content player for the user (column 9, line 58-column 10, line 50); and

transmitting information to a logging site each time the digital content data is at least one of played by the digital content player so that usage of the licensed digital content data can be tracked (column 11, lines 1-54).

However, Ahmad does not disclose the step of transmitting information to a logging site each time the digital content data is copied from the digital content player to an external medium. Wolfe discloses the step of transmitting information to a logging site each time the digital content data is copied from the digital content player to an external medium (column 4, lines 40-column 5, lines 45). It would have been obvious to one with ordinary skill in the art at the time the invention was made to use Wolfe's transmitting step as describe above in order to implement the method of Ahmad for the purpose of informing the logging site each time the digital content data has been copied to an external medium in order to control the number of times the digital content has been copied.

Regarding claim 15, Ahmad and Wolfe disclose everything claimed as applied above (see claim 14), int addition, Ahmad teaches the step of playing the licensed digital content data on the digital content player (column 10, lines 35-50).

Art Unit: 2764

Regarding claim 16, Ahmad and Wolfe disclose everything claimed as applied above (see claim 14), in addition, Ahmad teaches granting a license to the user by an electronic commerce host (column 9, lines 16-37).

Regarding claim 17, Ahmad and Wolfe disclose everything claimed as applied above (see claim 14), in addition, Ahmad teaches the step of storing the licensed digital content data on at least one of a hard disk, flash memory, a removable disk, and an optical disk (column 9, lines 38-65).

Regarding claim 18, Ahmad and Wolfe disclose everything claimed as applied above (see claim 17), in addition, Wolfe teaches the steps of:

copying the stored digital content data to the external medium, the external medium being one of a compact disc, a DVD disc, a mini-disc, flash memory, and a digital tape (column 5, line 55-column 6, line 63); and

transmitting information to the logging site each time the digital content data is copied from the digital content player to the external medium (columns 5-6).

Claims 20 and 21 contain the same limitations as claims 6 and 7, therefore are rejected by the same rationale.

Art Unit: 2764

Regarding claim 25, Ahmad discloses everything claimed as applied above (see claim 23), but fails to teach the steps of: copying the stored digital content data to one of a compact disc, a DVD disc, a mini-disc, flash memory, and a digital tape; logging copy information in the digital content player each time the digital content data is copied; and sending the logged copy information to the logging site at the predetermined time or at the predetermined intervals. Wolfe teaches the steps of: copying the stored digital content data to one of a compact disc, a DVD disc, a mini-disc, flash memory, and a digital tape; logging copy information in the digital content player each time the digital content data is copied; and sending the logged copy information to the logging site at the predetermined time or at the predetermined intervals (columns 5-8). It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine Wolfe's steps as described above in Ahmad method because it would improve the method of Ahmad by allowing the logging site can track the number of times the digital content data has been copied by the users.

Regarding claim 33, Ahmad discloses everything claimed as applied above (see claim 30), but fails to teach the step of tracking copying of the digital content data to external mediums at the logging site that receives the play information, the play information further including the number of times that the digital content data has been copied to an external medium by each user. Wolfe teaches the step of tracking copying of the digital

Art Unit: 2764

content data to external mediums at the logging site that receives the play information, the play information further including the number of times that the digital content data has been copied to an external medium by each user (columns 5-8). It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine Wolfe's steps as described above in Ahmad method because it would improve the method of Ahmad by allowing the logging site can track the number of times the digital content data has been copied by the users.

9. Claims 5, 9, 19, 26, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahmad, U.S. Patent No. 5,925,127 in view of Wolfe, U.S. Patent No. 4,796,220 and further in view of Official notice.

Regarding claim 5, Official notice is taken that it well-known in the art to download the digital content data includes digital music data over the Internet. It would have been obvious to one with ordinary skill in the art at the time the invention was made to implement the method of Ahmad and Wolfe by allowing users can purchase or rent digital music by downloading from the Internet.

Claims 9, 19, 26, and 34 contain the same limitations as claim 5, therefore are rejected by the same rationale.

Art Unit: 2764

10. Claims 37-44 are written in computer software and contain the same limitations as claims 14-21, therefore are rejected by the same rationale.

Conclusion

11. Claims 1-44 are rejected.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nga B. Nguyen, whose telephone number is (703) 306-2901.

The examiner can normally be reached on Monday-Thursday from 7:30 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell, can be reached on (703)305-9768.

13. **Any response to this action should be mail to:**

Commissioner of Patents and Trademarks

c/o Technology Center 2700

Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Art Unit: 2764

or:

(703) 308-5397 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II,

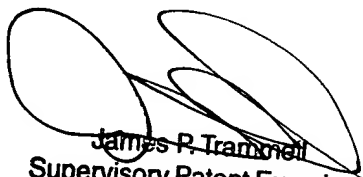
2121 Crystal Drive, Arlington.

VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)305-3900.

Nga B. Nguyen

September 8, 1999


James P. Tramontelli
Supervisory Patent Examiner
Technology Center 2700